REMARKS

Favorable reconsideration of this application, in light of the preceding amendments and following remarks, is respectfully requested.

Claims 1-19 [1] are pending in this application. By this Amendment, claims 1, 3-6, 8, 11-14, and 16 are amended, and claim 17 is added. Claims 1, 4, 5, 7, 9-12, and 14-17; and claims 18 and 19 are added. No new matter is added. Claims 1, 16, and 17 are the independent claims.

Applicant notes with appreciation the Examiner's acknowledgement that certified copies of all priority documents have been received by the U.S.P.T.O.

Applicant appreciates the Examiner's indication that the Information Disclosure Statement filed on September 29, 2006, has been considered.

Applicant also respectfully notes the present action indicates that the drawings have been accepted by the Examiner.

Applicant Initiated Interview Summary

The courtesies extended by Examiner Belcher to Applicant's representative, David J. Cho, during telephonic interviews conducted on August 31, 2010 and September 20, 2010, are acknowledged and appreciated. The substance of the interview is set forth in the Examiner's Interview Summary and in the following Applicant Initiated Interview Summary.

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[1] In the Office Action mailed June 3, 2010, the Examiner indicates that claims 1-16 are pending. However, Applicants submit that claims 1-17 were previously pending (and claims 18 and 19 have currently been added) – claims 1-19 are now pending.

As required by 37 C.F.R. § 1.133(b), Applicant's summary of that interview is as follows:

1.   Brief Description of any Exhibit Shown

No exhibit was shown or demonstrated during the interview.

2.   Identification of the Claims Discussed

The Examiner and Applicant's representative generally discussed independent claims 1 and 16.

3.   Identification of the Specific Prior Art Discussed

The Examiner and Applicant's representative discussed U.S. Patent No. 6,691,156 to Drummond et al. and U.S. Patent No. 6,351,764 to Voticky et al.

4.   Identification of the Proposed Amendments

Proposed amendments such as made herein were discussed or proposed.

5.   Summary of the Arguments Presented to the Examiner

Applicant's representative presented arguments regarding independent claims 1, 16, and 17, are sufficient to overcome the outstanding rejections thereof under 35 U.S.C. § 103(a) over the Drummond and Voticky references.

In particular, Applicant's representative presented arguments regarding the failure of the cited prior art references to disclose or suggest, "prioritizing means" and the "means for selecting identification insignias" as taught in claim 1, and similarly taught in independent claims 16 and 17. Examiner Belcher somewhat agreed that the prioritization of emails in Voticky is not "in response to recognition of the second message being a reply to the returned message," but continued to maintain that the applied references taught the above features. Applicant's representative then suggested that the references do not disclose the explicit operation of the "first

prioritizing means" (5) and the "second prioritizing means" (15), as shown in *FIG. 1* – particularly the "second prioritizing means (15)". Examiner Belcher was responsive to this proposal and stated that if the claims were amended to include the "second prioritizing means", it would appear to distinguish over the applied references.

6.   General Indication of Other Pertinent Matters Discussed

The Examiner also agreed that the objection to the specification regarding the priority paragraph and the objection to claim 11 have been obviated in the Amendment filed October 27, 2009.

7.   General Outcome of the Interview

The Examiner indicated that he understood the arguments advanced by Applicant's representative, and stated that if the claims were amended as made herein, it would distinguish over the applied references, upon further search. The Examiner further requested that Applicant file a formal response so that he may fully consider the amendments and/or arguments.

Objections to the Specification

The disclosure is objected to because the foreign priority information was not included in the specification. Applicant notes that the specification has previously been amended in the Amendment filed October 29, 2009 – see, e.g., page 2, to include the priority information. Applicant believes the objection to the specification appears to be in error. If, however, the Examiner continues to maintain the objection, Applicant respectfully requests further clarification so that Applicant may correct the objection. Withdrawal of the objection is respectfully requested.

Objections to the Claims

Claim 11 is objected to for informalities. In particular, the Examiner objected to the acronym "STMP". Applicant notes that claim 11 has previously been amended in the Amendment filed October 29, 2009, to obviate the objection. Withdrawal of the objection to the claim is respectfully requested.

Claim Rejections – 35 U.S.C. §112

Claims 1-16 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. This rejection is respectfully traversed.

Claims 1 and 16 have been amended, taking into consideration the Examiner's comments, to obviate the rejection. In particular, claims 1 and 16 have been amended to provide proper antecedent basis for the terms "first message" and "identification insignia."

Reconsideration and withdrawal of the rejection under 35 U.S.C. §112, second paragraph, are respectfully requested.

Claim Rejections - 35 U.S.C. § 103

Claims 1-4, 8, 9 and 14-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,691,156 ("Drummond") in view of U.S. Patent No. 6,351,764 ("Voticky"). Applicant respectfully traverses this rejection for the reasons discussed below.

Applicant respectfully submits that the Drummond and the Voticky references, individually or in combination, fail to disclose or suggest, will describe or suggest, *inter alia*:

> first prioritizing means which assigns a priority to each of the first identification insignias of the senders of the first message,
>
> first means for selecting the first identification insignias and adding the selected identification insignias to the allowed list and delivering the first message to the intended recipients, wherein the first means for selecting are adapted to carry out the selection according to the priorities assigned to the first identification insignias of the sending of the first messages.....
>
> second prioritizing means which, in response to recognition of the second message being a reply to the returned message, assigns a priority to each of the identification insignias of the senders of the returned messages, and
>
> second means for selecting identification insignias and adding the selected identification insignias to the allowed list, wherein the second means for selecting are adapted to carry out the selection according to the priorities assigned to the identification insignias of the sending of the returned messages.

As shown in an example, non-limiting embodiment, **FIG. 1** illustrates a process of filtering electronic messages, including receiving an email from a sender via the SMTP daemon on a TCP port 25 (RFC 821) on a receiving server 1. The receiving server may extract the sender insignia from the Mail From: on the SMTP protocol and the IP address of the sending server from the IP protocol 1, for example. The receiving server may then check the insignia against the black list 2 if the insignia is included in the black list, to reject the email and inform the sender's server about the rejected email via an error message on the SMTP protocol 3. If the insignia is not included in the black list, the receiving server may check the subject line from the mime message for a unique code and may compare the code and the insignia with the list of previously generated key pairs 4. If the incoming email does not contain a valid key pair, the

receiving server may then check if the insignia is on the allow list 13. If the insignia is not on the allow list, the receiving server will send back a reply request to the sender generating an error message on the SMTP protocol that may inform the sending server that the email could not be received because the sender is not registered as a valid sender of mail to the receiver 14. Then, the SMTP communication may be either closed by the sending server or a new email may be delivered to the receiving server. The receiving server may then prioritize the incoming email according to a given rule set and may assign a priority value to the email message 15. If the assigned value does not exceed a given threshold value, a Unique ID may be generated by the receiving system 18. The incoming email, insignia and Unique ID may then be stored by the receiving server for later retrieval 19. The receiving server may send an email to the sender of the incoming email asking to reply to it without changing the subject line of the mime message (RFC 822) 20. Further, if the incoming email did get a priority value exceeding the given threshold value 16, the insignia of the sender may be added to the allow list 17; and if the incoming email sender insignia was on the allow list 13, then the receiving server may capture the CC: from the mime message and may store them for later retrieval 11. The email may then finally be delivered to the recipient mall box or forwarded to be delivered to the next hop of recipient 12.

Optionally, if the email did contain a valid key pair 4 (instead of an invalid key - as discussed above), the receiving server will prioritize the email message 5 and assign it a priority value. If the assigned value does not exceed a given threshold, the choice of allowing the email is up to the administrator 7. If the email is not approved by the administrator, the original message, unique ID and insignia may be deleted from storage space 8. If the email is approved by the administrator or had a priority value

exceeding the threshold 6, the insignia may be added to the allow list 9. The receiving system may then inform the sender by sending an email that he may now send emails to the recipient and that the previously sent email will be delivered 21. The receiving system may capture the CC: from the mime message and may store them in the predict allow list for later retrieval 11. The email may then be delivered to the recipient mail box or forwarded to the next hop 12, and the receiving system may delete the Email, insignia and unique ID from storage 10.

In the outstanding Office Action, the Examiner states that Voticky discloses the "prioritizing means" and "means for selecting identification insignias," as taught by claim 1.[2] However, Applicant submits that Voticky is completely silent of teaching or suggesting "second prioritizing means" (i.e., element 15) and "second means for selecting identification insignias" (i.e., elements 17 and 18). On the contrary, the system of Voticky uses the insignia to assign a priority to an e-mail message via a single priority means. The result of the priority is then used to categorize a specific e-mail. Further, the priorities of Voticky are assigned to the e-mails itself, not to the identification insignias, as taught by claim 1. Moreover, the means for selecting identification insignia of claim 1 is also a means for adding the selected insignias to the allowed list. Hence, the means may be adapted to carry out the selection according to the priorities.

Accordingly, Applicant respectfully submits that the Drummond and Voticky references, individually or in combination, fail to disclose, or even suggest, "second prioritizing means which, in response to recognition of the second message being a reply to the returned message, assigns a priority to each of the identification insignias

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[2] See Office Action mailed June 3, 2010, page 6, last two paragraphs.

of the senders of the returned messages" and "second means for selecting

identification insignias and adding the selected identification insignias to the allowed

list, wherein the second means for selecting are adapted to carry out the selection

according to the priorities assigned to the identification insignias of the sending of the

returned messages," as recited in amended claim 1.

Since the rejection fails to disclose or suggest each and every element of the

rejected claims, Applicant respectfully submits that no *prima facie* case of obviousness

has been established with respect to amended claim 1.

In view of the above, Applicant respectfully submits that the Drummond and

Voticky references, individually or in combination, fail to teach or suggest each and

every element of claim 1, and, therefore, claim 1 is allowable over this cited art.

Claims 2-4, 8, 9, 14, and 15 are dependent from claim 1, and therefore, also allowable.

Claim 16 (and claim 17) is directed to a method claim which corresponds to

claim 1. Applicant respectfully submits that this claim is also allowable for the similar

reasons presented above in regard to amended claim 1.

Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. §

103(a) be reconsidered and withdrawn.

Claims 5, 10, 11 and 13 are rejected under 35 U.S.C. § 103(a) as being

unpatentable over Drummond and Voticky in view of U.S. Patent Application

Publication No. 2004/0205127 ("Ben-Yosef"). Applicant respectfully traverses this

rejection for the reasons discussed below.

Claims 5, 10, 11 and 13 are believed to be allowable for at least the reasons set

forth above regarding claim 1. The Ben-Yosef reference fails to provide the teachings

noted above as missing from the Drummond and Voticky references. Since claims 5, 10, 11 and 13 are patentably at least by virtue of their dependency on claim 1, Applicant respectfully requests that the rejection of claims 5, 10, 11 and 13 under 35 U.S.C. § 103(a) be withdrawn.

Claim 12 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Drummond and Voticky and Ben-Yoseph in view of U.S. Patent No. 6,330,590 ("Cotten"). Applicant respectfully traverses this rejection for the reasons discussed below.

Claim 12 is believed to be allowable for at least the reasons set forth above regarding claim 1. The Cotten reference fails to provide the teachings noted above as missing from the Drummond and Voticky references. Since Claim 12 is patentably at least by virtue of their dependency on claim 1, Applicant respectfully requests that the rejection of claim 12 under 35 U.S.C. § 103(a) be withdrawn.

New Claim

Claims 18 and 19 have been added in an effort to provide further, different protection for Applicant's invention. For instance, claims 18 and 19 correspond to claim 2, but dependent on claims 16 and 17, respectively. No new matter is added.

Request for Interview

Applicant respectfully requests, if the application is <u>not</u> in condition for allowance, that the Examiner contact Applicant's representative in order to discuss and resolve the outstanding issue(s).

CONCLUSION

In view of the above remarks and amendments, Applicants respectfully submit that each of the pending objections and rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. Further, the above remarks demonstrate the failings of the outstanding rejections, and are sufficient to overcome the rejections. However, these remarks are not intended to, nor need they, comprehensively address each and every reason for the patentability of the claimed subject matter over the applied prior art. Accordingly, Applicants do not contend that the claims are patentable solely on the basis of the particular claim elements discussed above.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant hereby petitions for a one (1) month extension of time for filing a reply to the outstanding Office Action and submit the required $65 extension fee herewith.
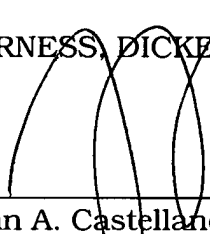
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned, at the telephone number below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY, & PIERCE, P.L.C.

By   _____

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